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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,775	03/30/2001	Robert E. Krall	PROV1100-1	9642

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/823,775

Applicant(s)
KRALL et al.

Examiner
Pak, J.

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1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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This application is a Reissue application of 09/151,621, Pat. No. 6,037,366.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,037,366 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

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An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action. It is noted in this regard that applicant checked a box in the 3.73(b) statement to indicate “[c]opies of assignments or other documents in the chain of title are attached,” but no such papers could be found in the file contents of this application.

This application is objected to under 37 CFR 1.173 for the following reasons:

- (1) Columns 1-2 of the patent specification is missing. 37 CFR 1.173(a);
- (2) The marked-up version of column 4 is not in accordance with 37 CFR 1.173(b). See MPEP 1411, page 1400-11 (August 2001);
- (3) Note also that the preliminary amendment (Express mail deposit date of 3/30/01) contains the same amendment of claims 1, 3 and 6 as the marked-up column 4 of the patent. Should claims 1, 3 and 6 be indicated as having been “twice amended” there? 37 CFR 1.173(b)(2).

Claims 1-22 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

- (1) Independent claims 1, 5, 6, 11, 17 and 20 recite a “fatty acid ester” in part 2. Applicant disclosed in the originally filed disclosure “[a]ny of the large chain fatty acid esters will work to replace ethyl myristate so long as they are liquids” (patent column 2, lines 1-3). Hence,

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applicant did not originally disclose any fatty acid esters – only liquid long chain fatty acid esters were disclosed. Fatty acid ester, without such limitations, is new matter.

(2) Independent claims 6 and 11 recite a cyanoacrylate in part 1 and a stabilized polymer of cyanoacrylate in part 2. Applicant disclosed in the originally filed disclosure that part 2 must contain a polymer “of the same cyanoacrylate [as in part 1]” (sentence bridging patent columns 1 and 2). Instant claims 6 and 11 read on polymer of cyanoacrylate that does not necessarily have to be the cyanoacrylate of part 1. This is new matter.

(3) Independent claim 11 recites “cyanoacrylate” as a component of part 1. Applicant disclosed in the originally filed disclosure that the cyanoacrylate in part 1 must be a “liquid monomer” (patent column 1, line 59). Opening up the scope of cyanoacrylates by removing such limitations is new matter.

(4) Independent claims 6, 11, 17 and 20 recite a “radiopaque metal powder” as a component of part 2. Applicant disclosed in the originally filed disclosure gold as the chosen ingredient. Nothing in the originally filed disclosure conveys use of radiopaque metal powders other than gold. Patent column 3, lines 43-45 provide the only peripheral mention:

Gold

Tantalum, platinum and gold are all radiopaque. Gold was best for us because it could be suspended colloidally in the mixture. One gram of gold is used per device.

Such disclosure only makes clear that gold was chosen as the suitable metal from an initial candidate group of three radiopaque metals, but it fails to convey that all other radiopaque metals, let alone tantalum or platinum, would be suitable alternatives. Nowhere in the originally

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disclosure is it stated that other metals may actually be used. Given the medical sensitivity of the intended use, lack of adequate conveyance that tantalum or platinum, or any other radiopaque metals (e.g. tungsten, palladium, silver, copper, titanium, etc.) may be substituted for gold would lead the skilled artisan to recognize that gold is the only disclosed and suitable metal in accordance with applicant's invention.

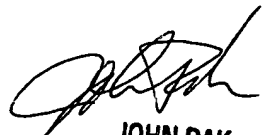
For these reasons no claim can be allowed at this time.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK
PRIMARY EXAMINER
GROUP 1600